

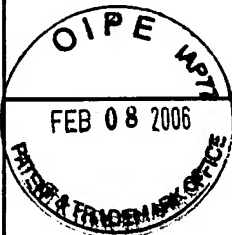
TRANSMITTAL OF APPEAL BRIEF (Small Entity)

Docket No.
HAY-P002

In Re Application Of: **Kenneth O. Hayes**

Application No. 10/689,337	Filing Date October 20, 2003	Examiner Robert C. Watson	Customer No. 27268	Group Art Unit 3723	Confirmation No. 2899
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Invention: **WEED EXTRACTOR**



COMMISSIONER FOR PATENTS:

Transmitted herewith is the Appeal Brief in this application, with respect to the Notice of Appeal filed on:

☒ Applicant claims small entity status. See 37 CFR 1.27

The fee for filing this Appeal Brief is: **\$250.00**

- ☒ A check in the amount of the fee is enclosed.
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Thomas A. Ladd
Signature

Dated: February 6, 2006

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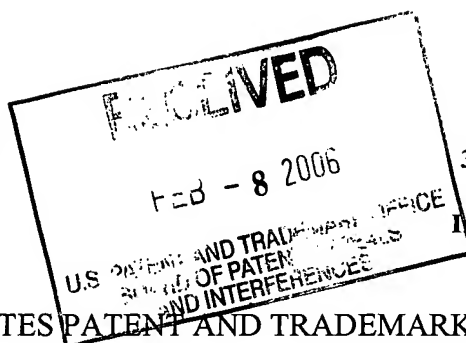
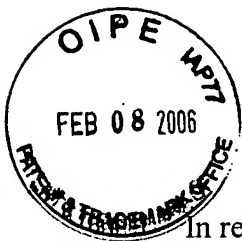
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Kenneth O. Hayes)

Application No.: 10/689,337)

Filed: October 20, 2003)

Title: WEED EXTRACTOR)

Examiner: WATSON, Robert C.)

Confirmation No.: 2899)

Atty. Docket No.: HAY-P002-US

Group Art Unit No.: 3723

CERTIFICATE OF MAILING
(37 C.F.R. § 1.8(a))

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Loretta Allemenos
February 6, 2006

Board of Patent Appeals and Interferences
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APPEAL BRIEF

Sir:

Applicant submits its Appeal Brief in its appeal of its patent application referenced above.

I. Real party in interest:
Kenneth O. Hayes
3975 Ironwood Court
Bloomington, IN 47505

II. Related appeals and interferences:
None

III. Status of claims:

Claims 1, 4, 5, 6, 7, , 10, 11-14, 15, 16 and 19 stand rejected.
Claims 2, 3, 8, 9, 17 and 18 are objected to.
Claim 20 is withdrawn.

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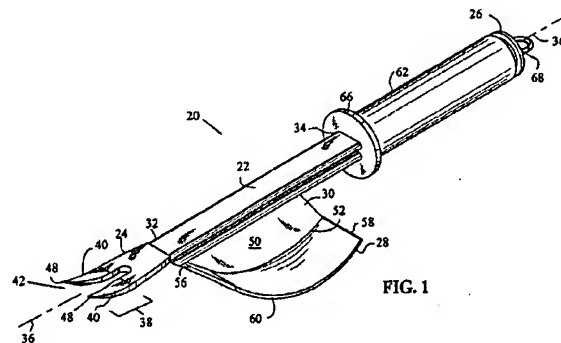
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IV. Status of amendments:

No amendments were filed subsequent to final rejection.

V. Summary of claimed subject matter:

Applicant tenders as a summary of claimed subject matter the prospective drawing of



The invention relates to hand tools. [0001]

Claim	Claim Element	Specification Support
1.	A tool,	[0001], [0004]
	comprising	
	a body member having a longitudinal axis;	[0021]
	a blade fixed to said body;	[0022]
	an arcuate support spaced from said longitudinal axis having a length; and	[0008], [0024]
	a web substantially spanning said arcuate support and said body along said length of said arcuate support.	[0008]

Claim	Claim Element	Specification Support
4.	The tool of claim 1,	
	wherein	
	said arcuate support having a face,	[0006], [0009]
	said face of said support transverse to a midline of said face is substantially linear;	[0009]
	said web is substantially planar; and	[0009]
	said face is substantially perpendicular to said web.	[0009]
5.	The tool of claim 1	
	further comprising	
	a handle adjacent said second body end.	[0026]
6.	The tool of claim 5,	
	further comprising	
	a loop hanger fixed to at least one of said body and said handle.	[0028], as an unamended claim, claim 6 is support for itself. <i>Wettstein v Campbell</i> 139 USPQ 341, (BPOI, 1962).
7.	The tool of claim 1,	
	wherein	
	said blade defines a pair of forked tines.	[0006]
10.	The tool of claim 1	
	wherein	
	at least one of said body, said blade, said arcuate support and said web are integrally formed from a composite material.	[0005]
11.	A tool,	[0001], [0004]
	comprising	
	a body member having a longitudinal body axis and a first and a second body end;	[0009], [0021]
	a blade fixed to said body; and	[0010]

Claim	Claim Element	Specification Support
	a support having a face, said face having a first and a second face end,	[0020], [0024]
	said face defining a midline connecting said first and second face ends,	[0009]
	said midline located in a plane coincident with said longitudinal body axis, said face being arcuate along said midline.	[0009]
12.	the tool of claim 11,	
	further comprising	
	a web coupling said body member to said support along said midline	[0004], [0023], [0024]
13.	The tool of claim 12,	
	wherein said face includes a portion between said first face end and said second face end being substantially wider than said blade.	[0024]
14.	The tool of claim 11, second body end.	
	further comprising	
	a handle fixed to said body adjacent said second body end.	[0020], [0027]
15.	The tool of claim 14,	
	further comprising	
	a loop hanger fixed to at least one of said shaft and said hanger.	[0028], as an unamended claim, claim 15 is support for itself. <i>Wettstein v Campbell</i>
16.	The tool of claim 12,	
	wherein	

Claim	Claim Element	Specification Support
	said blade includes a pair of forked tines.	[0006]
19.	The tool of claim 12,	
	wherein	
	at least one of said body, said blade, said arcuate support, and said web are integrally formed from a composite material.	[0005]

VI. Grounds of rejection to be reviewed on appeal:

Claims 1-19 are pending.

Claim 20 was withdrawn from prosecution.

Claims 1, 4, 5, 7, , 11-14 and 16 stand rejected pursuant to U.S. Patent 5,609,325 in view of U.S. Patent 4,368,874 for obviousness pursuant to 35 U.S.C. §103(a).

Claims 6 and 15 stand rejected pursuant to 35. U.S.C. §103(a) over U.S. Patent 5,609,325 in view of U.S. Patent 4,368,874 and further in view of U.S. Patent 4,472,986.

Claims 10 and 19 stand rejected pursuant to 35 U.S.C. §103(a) over U.S. Patent 5,609,325 in view of U.S. Patent 4,368,874 further in view of U.S. Patent 6,848,341.

Claims 2, 3,8, 9, 17 and 18 stand objected to as being dependent upon a rejected base claim.

Applicant appeals rejected claims 1, 4, 5, 7, 11-14 and 16.

VII. Argument.

A. Claims 1, 4, 5, 7, 11-14 and 16 stand rejected pursuant to 35 U.S.C §103(a).

The First Office Action (hereafter sometimes referenced as "OA") described U.S. Patent 4,368,874 as

To provide in DeArmond ['325] a web to substantially span the arcuate support and body would have been obvious to one skilled in the art at the time the invention was made in view of the disclosure of Weisgerber ['874]. One of ordinary skill in the art would have been motivated to do this in order to strengthen the tool."

OA, 7/38/2005, p. 2.

The Final Office Action (hereafter sometimes referenced as "FOA") continued to assert the "web 48 extends to the arcuate support 12." FOA, 12/5/2005, p. 2.

The author apparently is viewing a different reference than the applicant.

The number referenced in the FOA as the "arcuate support 12" is identified in the '874 reference as a "unitary metal base plate 12" Col. 3, line 6. The "unitary metal base plate is comprised of a planar heel portion 16 (Col. 2, line 40, emphasis supplied), a "curved intermediate portion 18" (Col. 3, line 18), and a "sole portion 14" (Col. 3, lines 17 – 18).

The '874 reference discloses "[a] flat metal brace 48 . . . secured, as by welding, between the [planar] heel portion of the base plate and the handle 22" (Col. 3, lines 24 – 26 (emphasis supplied). In contrast to attachment to an "arcuate support" of the claimed invention, the brace 48 is attached to a "planar heel" 16.

A member cannot be both "arcuate" as urged in the OA and FOA and "planar" as stated in the reference. The suggestion in the prosecution record to the contrary finds no support in the reference of record. 'Arcuate' is the antithesis of 'planar'. As such, the '874 reference teaches away from applicant's invention, as claimed.

A cited reference must be considered as a whole. *Ex parte Clayton* 205 USPQ 269, 272-273 (POBA, 1979). Considering the '874 reference in its entirety, by disclosing a planar portion, the '874 reference teaches away from applicant's claimed invention. Accordingly, the '874 reference may not be fairly combined with other references because it teaches away from the claimed invention. *Ecolochem v Southern California Edison*, 227 F.3d 1361, 1373, 56 USPQ2d 1065, 1073 (Fed.Cir., 2000); *In re Gurley* 27 F.3d 551, 553, 31 USPQ2d 1130, 1331-32 (Fed.Cir, 1994).

In spite of the disclosure of the applied reference, the OA of 7/28/05 states that '874 "teaches that web 48 may be substantially an arcuate support 12 and a body 22", OA 07/28, 2005, p. 2 (emphasis supplied). Contrary to the direction of 37 CFR 1.104(c)(2), no portion of the '874 reference is cited as supporting the assertion.

Further, in the FOA, of 12/05/2005 it is further stated:

In Weisgerber ['874] the web 48 extends completely (not incompletely) from the body 22 to the arcuate support 12 and may therefore be said to span 100% of the distance between the arcuate support and the body, i.e., a 100% span between the body 22 and the arcuate support 12.

FOA, 12/5/2005, p. 2 – 3.

While the brace 48 of '874 may extend the entire distance from the handle straight portion 26 (Col. 2, lines 59 – 60) to the planar heel portion 16, applicant's claims 1, 4, 5, 7, 12-14 and 16 are directed to "a web substantially spanning said arcuate support and said body along the length of said arcuate support". The reference in the prosecution record to

100% of the distance between the arcuate support and the body,
i.e., a 100% span between the body 22 and the arcuate support 12

FOA, 12/05/2005, p. 2.

is a semantic obfuscation of the teaching of the reference: 1) that the connection between the body 22 and the planar heel is in no way 'arcuate', and 2) the claim element is directed to the span of a web along the length of the support, which clearly is not present in the '874 reference.

The primary reference, US 5,609,325 discloses no web or equivalent member whatsoever between the shaft 30 (Col. 3, line 25) and leverage member 70 as would correspond to the arcuate support of applicant's claims. Thus, secondary reference '874 provides the entire basis of record to find the web substantially spanning the arcuate support along the length of said arcuate support according to applicant's claims.

It is beyond peradventure that the flat metal brace 48 of the '874 reference has no connection to the sole portion 14 of the unitary metal brace 12. The unitary base plate 12 of the '874 reference is comprised of flat metal including a planar heel portion 16. (Col. 2, line 40). In contrast, applicant's claims are directed to an arcuate support, and a web substantially spanning the arcuate support. If the base plate 12 is deemed to correspond to the claimed arcuate support, then the base plate lacks the "web substantially spanning" element.

The FOA substitutes assertions about the level of skill in the art for motivation to combine the prior art references, yet supporting affidavits are not provided in support of the assertion 37 CFR §1.104 (d)(2). *In re Jones* 958 F.2d 347, 21 USPQ2d 1941 (Fed.Cir. 1992) discussed the circumstances for combining references in depth in the context of structural similarity of chemical homologs. The holding, however, is not limited to chemical homologs.

Before the PTO may combine the disclosures of two or more prior art references in order to establish *prima facie* obviousness, there must be some suggestion for doing so, found either in the references themselves, or in the knowledge generally available to one of ordinary skill in the art. *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598-99 (Fed. Cir. 1988).

Conspicuously missing from this record is any *evidence*, other than the PTO's speculation (if it be called evidence) that one of ordinary skill in the herbicidal art would have been motivated to make the modifications of the prior art salts necessary to arrive at the claimed 2-(2'-amionethoxy) ethanol salt.

Id. at 958 F.2d 351, 21 USPQ2d 1943-1944.

In an infringement/validity context the rule was repeated in *Ecolochem, Inc. v Southern California Edison*, 227 F.3d, 1361, 56 USPQ2d 1065 (Fed.Cir., 2000). There a district court finding of claims as obvious over prior art was under review.

Because we do not discern any evidentiary basis for the finding by the district court that there was a suggestion, teaching, or motivation to combine the prior art references cited against the claimed invention, the district court's conclusion of obviousness cannot stand.

Id. 227 F.3d at 1375, 56 USPQ2d at 1075.

Similarly in the instant examination, missing from the OA is any evidence of motivation to combine the '325 and '874 references. No teaching or suggestion is identified in the references themselves. The prosecution record attempts to substitute "an obvious matter of design choice" for evidence of motivation to combine references. The "obvious matter of design choice" suggested is "to increase the length of the span to therefor [sic, therefore] increase the strength of the device." FOA, 12/05/05, p. 3. If enlarging the brace in '874 to substantially span the length of the planar heel portion 16, or to include the planar sole portion 14, is obvious, then why was

that not the choice in the '874 reference? If the web of the instant invention is "an obvious matter of design choice", then why is there no member whatsoever in the '325 reference corresponding to the web of applicant's claim?

The "obvious matter of [] design choice" language in the record of the instant application is a conclusion, not a reason.¹

Because the combined references do not arrive at the claimed invention, the rejection of claims is improper and must be reversed. *In re Oetiker* 977 F.2d 1443, 1447, 24 USPQ2d 1443,1444, (Fed.Cir. 1992).

Prior art references must be considered as a whole.

[T]he references are to be evaluated by ascertaining the features, fairly disclosed therein, as a whole. It is impermissible, in the first instance, to ascertain visually what the appellant did and then view the prior art in such a manner as to select from the random features of the art only those which may be modified and then utilized to reconstruct the appellant's invention from such prior art. Compare *In re Shuman et al.* 53 CCPA 1251, 361 F.2d 1008, 150 USPQ 54 (1966).

Ex parte Clayton, 205 USPQ 269, 272-273, (POBA, 1979)
emphasis supplied.

Considering the '325 reference, as a whole, the element corresponding to support 28 of applicant's disclosure in the '325 reference is leverage member 70. Applicant discloses the claimed tool may be constructed of "plastic or a composite such as a glass fiber reinforced polymer". [0005] '325 discloses leverage member 70 may be formed of plastic. '325, Col. 3,

¹ The Board of Patent Appeals and Interferences is reported to have stated as much by the secondary reference, BNA, Patent Trademark & Copyright Journal, November 13, 1986, in the case of *In re Garrett*, September 30, 1986. Applicant engaged a document retrieval firm to locate the text of this unpublished opinion for inclusion with this Brief. The document retrieval firm reported that the file cannot be located at the Patent Office. As a consequence, applicant is left with the secondary report as support. A photocopy is attached as Exhibit 1.

line 27. Yet, although the claimed tool and the prior art tool of '325 may be made of a plastic material, no web according to applicant's claims is disclosed in '325.

Next, considering the '874 reference, as a whole, the unitary sole plate 12 of the '874 reference is disclosed as "metal". '874, (Col. 2, lines 36 – 37). The brace 48 is secured to the planar heel portion 16 "as by welding". '874, (Col. 3, lines 24 – 25). Extending the brace 48 to "substantially span[] said arcuate support and said body along said length of said arcuate support" according to the teachings of '874 would require extending the weld, including the time, labor, and material associated therewith. It was left to applicant to resolve manufacture of the tool without welding, such as by molding. [0005].

In the absence of motivation to combine, the references may not be fairly considered in *pari materia*. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596, (Fed.Cir., 1988) recognizes that obviousness is tested by

"what the combined teachings of the reference would have suggested to those of ordinary skill in the art." *In re Keller*, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). But it "cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination." *ACS Hospital Sys[tems, Inc. v Montefiore Hospital.]* 732 F.2d 1572, 1577, 221 USPQ 929, 933. And "teachings of references can be combined only if there is some suggestion or incentive to do so." *Id.*

In re Fine, 837 F.2d at 1074, 5 USPQ2d at 1599.

In lieu of identifying relevant prior art and identifying in the art a motivation to combine relevant art to render obvious applicant's claims, the prosecution record discloses that applicant's claims served as a skeleton on which to hang elements from the prior art. This approach is condemned by this Board.

In the instant application, the examiner has done little more than cite references to show that one or more elements or subcombinations thereof, when each is viewed in a vacuum, is known. The claimed invention, however, is clearly directed to a combination of elements. That is to say, appellant does not claim that he has invented one or more new elements but has presented claims to a new combination of elements. To support the conclusion that the claimed combination is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed combination or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references. We find nothing in the references that would expressly or impliedly teach or suggest the modifications urged by the examiner. Additionally, as aforementioned, we find no line of reasoning in the answer, and we know of none, as to why the artisan would have found the modifications urged by the examiner to have been obvious. Based upon the record before us, we are convinced that the artisan would not have found it obvious to selectively pick and choose elements or concepts from the various references so as to arrive at the claimed invention without using the claims as a guide. It is to be noted that simplicity and hindsight are not proper criteria for resolving the issue of obviousness. Note *In re Horn*, 203 USPQ 969, 971 (CCPA 1979).

Ex parte Clapp, 227 USPQ 972, 973 (BPAI, 1985) emphasis supplied.

Summarizing, applicant has demonstrated that with respect to claims 1, 5, 7, 11-14 and 16 rejected pursuant to 35 USC §103(a):

- 1) the references of record do not support the disclosures for which they are cited in the record, accordingly, the invention as claimed is not disclosed or rendered obvious even if the disclosure of the '325 and '874 references is combined;
- 2) the combination of references is improper because the record contains no motivation to combine the references;

3) the prosecution record discloses that features were selected from among the prior art using applicant's claims as a guide.

B. Claims 6 and 15 stand rejected over the '325, and '874 reference with the additional reference US Patent 4,472,986.

Applicant incorporates by reference the discussion above concerning the '325 and '874 references.

The '986 reference is relied upon to disclose a loop hanger. The addition of the '986 reference for disclosure of the loop hanger feature appears superfluous in view of "hole 80 . . . for hanging the device" in '325, Col. 3, lines 34 – 37.

Nonetheless, in view of applicant's arguments above, claims depending from novel and unobvious claims are themselves unobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596, 1600. (Fed.Cir., 1988).

C. Claims 10 and 19 stand finally rejected over US Patent 5,609,325, in view of US Patent 4,368,874, and further in view of US 6,848,341.

Applicant incorporates by reference the discussion above concerning the '325 and '874 references.

The office actions offer no specificity as to which portion of the '341 reference is significant, contrary to 37 CFR §1.104(c)(2). The office actions state only: "[341] teaches that a tool may be made of composite materials." OA, 07/28/05, p. 3, repeated verbatim in FOA, 12/05, 2005, p. 3. There follows an assessment of the ordinary skill in the art as an apparent substitute for the lack of motivation to combine found in the applied prior art references.

The '341 reference concerns a hammer. The focus of the attention of the OA to the '341 reference is not apparent from the reference. The term "composite" appears at Col. 5, lines 8 – 10, but only in relation to the composition of a grip on the handle, not the hammer itself. To be accurate, the remarks in the prosecution record stating that "a tool may be made of composite materials" would in connection to the '341 reference necessarily refer to the "tool", i.e., the hammer. This is an overstatement in the prosecution record. The applied reference makes clear that the composite does not relate to the tool/hammer, but to the grip for the handle for the tool/hammer. Applicant's claim elements do not separately address a handle grip. Applicant finds no support for the suggestion that the '341 reference discloses a composite 'tool'. The prosecution record is also devoid of support for the statement. 37 CFR §1.104(c)(2).

The casual citing of the '341 reference for a feature totally unrelated to the claims supports applicant's urging that this prosecution record demonstrates that features from the prior art were collected using applicant's claims as a guide.

D. Conclusion.

Each, and every basis articulated by the prosecution record is substantively rebutted above.

Using applicant's claims as a skeleton, the examination locates features of the claims in an assortment of references, strung together by an unsupported assertion of what "would have been obvious for one skilled in the art at the time the invention was made." FOA, p. 3. This statement is a conclusion, not a reason. This statement fails to identify the skill level, experience or otherwise specify the skilled artisan. Moreover, the conclusion does not substitute for prior

art teaching or suggestion of the desired modifications. Even if the references are fairly assembled, the combined references must arrive at the claimed invention.

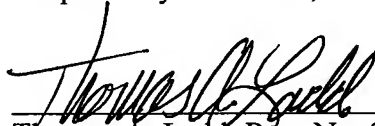
The combined references fail to arrive at applicant's claims. The primary reference, 325, is devoid of applicant's claimed arcuate support. The secondary reference '874 relied upon to supply the missing arcuate support fails to provide the support "along the length of said arcuate support." Thus, even if fairly combined, the references fail to arrive at the claimed invention.

E. Relief Requested.

Applicant's request that

- 1) claims 1 – 19 be allowed over the art of record as novel, unobvious and having utility;
- 2) the term of applicant's patent be extended by the term of delay caused by this appeal 35 USC §154.

Respectfully submitted,



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Dated: 6 February 2006

II Claims Appendix

1. (Original) A tool, comprising:
a body member having a longitudinal axis;
a blade fixed to said body;
an arcuate support spaced from said longitudinal axis and having a length; and
a web substantially spanning said arcuate support and said body along said length of said arcuate support.
2. (Previously Amended) The tool of claim 1, wherein
said body member includes a first and a second body end, said blade fixed at said first body end; and
said arcuate support having a face, said face includes a first face end and a second face end, said first face end being fixed to said body adjacent said blade, said second face end spaced from said body between said first body end and said second body end.
3. (Original) The tool of claim 2, wherein said face includes a portion between said first face end and said second face end being substantially wider than said blade.
4. (Previously amended) The tool of claim 1, wherein
said arcuate support having a face, said face of said support transverse to a midline of said face is substantially linear;
said web is substantially planar; and
said face is substantially perpendicular to said web.
5. (Original) The tool of claim 1, further comprising a handle adjacent said second body end.
6. (Original) The tool of claim 5, further comprising a loop hanger fixed to at least one of said body and said handle.
7. (Original) The tool of claim 1, wherein said blade defines a pair of forked tines.
8. (Original) The tool of claim 7, further comprising reinforcing beads along at least one of said tines and a central portion of said blade.
9. (Original) The tool of claim 1, wherein said body includes an I-beam cross-section.

10. (Original) The tool of claim 1, wherein at least one of said body, said blade, said arcuate support, and said web are integrally formed from a composite material.

11. (Original) A tool, comprising:

a body member having a longitudinal body axis and a first and a second body end;

a blade fixed to said body; and

a support having a face, said face having a first and a second face end, said face defining a midline connecting said first and second face ends, said midline located in a plane coincident with said longitudinal body axis, said face being arcuate along said midline.

12. (Original) The tool of claim 11, further comprising a web coupling said body member to said support along said midline.

13. (Original) The tool of claim 12, wherein said face includes a portion between said first face end and said second face end being substantially wider than said blade.

14. (Original) The tool of claim 11, further comprising a handle fixed to said body adjacent said second body end.

15. (Original) The tool of claim 14, further comprising a loop hanger fixed to at least one of said shaft and said hanger.

16. (Original) The tool of claim 12, wherein said blade includes a pair of forked tines.

17. (Original) The tool of claim 16, further comprising reinforcing beads along at least one of said forked tines and a central portion of said blade.

18. (Original) The tool of claim 12, wherein said body includes an I-beam cross-section.

19. (Original) The tool of claim 12, wherein at least one of said body, said blade, said arcuate support, and said web are integrally formed from a composite material.

20. (Original) A method of making a tool, comprising the steps of:

forming a body member having a first and a second body end;

forming a blade fixed at said first body end;

forming an arcuate support fixed to said body between said first and second body ends;

and

forming a web fixed between said body and said arcuate support.

IX. Evidence Appendix

None.

X. Related Proceedings Appendix.

None.

of trade secrets, plaintiff accused the defendants of violating and conspiring to violate RICO, 18 USC 1962(c)(d). The defendants moved to dismiss for failure to state a claim upon which relief may be granted.

To state a civil cause of action under RICO, Chief Judge Pratt explains, plaintiff must allege: (1) conduct (2) of an enterprise (3) through a pattern (4) of "racketeering activity" which has caused injury to plaintiff. Pursuant to 18 USC 1961(5), the court notes, a pattern "requires at least two acts of racketeering activity, one of which occurred within ten years * * * after the commission of a prior act of racketeering activity."

Many courts, Chief Judge Pratt observes, have held that where the predicate acts all occurred in the course of a single scheme to defraud, a pattern of racketeering has not been established. Such an interpretation, the court indicates, is consistent with Congress' intent to exclude isolated criminal conduct from RICO liability.

Adopting this interpretation, Chief Judge Pratt holds that separate acts in furtherance of the same criminal episode do not constitute a "pattern" of racketeering activity under RICO.

Since the alleged indictable conduct in this case was all performed in furtherance of a single scheme to steal and sell plaintiff's trade secrets, the court declares, the counts of the complaint alleging a violation of RICO must be dismissed.

Copyrights, Infringement: A juke box operator who affixed the requisite registration certificate inside the juke box is held liable for copyright infringement. Under §116(b) of the Copyright Act, the U.S. District Court for the District of Massachusetts explains, the certificate must be affixed in a place where it is visible to the public. By way of relief, Judge Freedman awards plaintiff minimum statutory damages of \$250 for each of the nine infringements. (*Broadcast Music, Inc. v. Dugas Music Service*, 9/24/86).

Patents, Obviousness: The PTO Board of Patent Appeals and Interferences, in reversing an obviousness rejection, criticizes the examiner's statement that the proposed modification would have been "an obvious matter of engineering design choice." Such an assertion is a conclusion, not a reason, the board points out. (*In re Garrett*, 9/30/86).

The claimed invention pertains to a drill string stabilizer. All the claims at issue were rejected under 35 USC 103 for obviousness. The examiner stated that:

Furthermore, wear blades having parallel sides

are previously well known in the prior art and one of ordinary skill in the art would, through routine engineering design choice, elect to provide a borehole contacting apparatus with blades having parallel sides.

The board reverses the rejection. Examiner-in-Chief Lindquist indicates that the examiner's statement sets forth a conclusion, not a reason.

Intellectual Property, Supreme Court: The Supreme Court, on November 10th, declined to review the following cases:

Chicago Systems Software v. Evans Newton, Inc., No. 86-441, in which petitioner questioned the Seventh Circuit's interpretation of the "work for hire" doctrine. See 32 PTCJ 671.

Darby Dental Co. v. Premier Dental Co., No. 86-480, wherein petitioner protested the Third Circuit's reading of §526 of the Tariff Act of 1930 as proscribing the unauthorized importation of any foreign-made goods bearing a domestically owned trademark. See 32 PTCJ 671.

Government Patents, Licenses: The Navy intends to grant Mankind Research Unlimited Inc., of Maryland, a revocable, nonassignable, limited exclusive license under the government-owned patent entitled "Cable Connector." See 51 Fed. Reg. 40063, 11/4/86.

The proposed license will be granted unless the Office of the Chief of Naval Research receives, within 60 days, written objections to the grant, along with supporting evidence establishing that the grant would not be in the public interest.

For further information, contact: Mr. R. J. Erickson, staff patent attorney, Office of the Chief of Naval Research, Code 00CCPP1, Ballston Tower No. 1, 800 N. Quincy Street, Arlington, Virginia 22217-5000.

Government Patents, Licenses: The National Technical Information Service (NTIS) intends to grant Lehn & Fink Products Group, Sterling Drug, Inc., of Montvale, New Jersey, an exclusive license under the government-owned patent applications entitled "Cockroach Repellents." See 51 Fed. Reg. 40350, 11/6/86.

The proposed license will be granted unless NTIS receives, within 60 days, written evidence and argument establishing that the grant would not serve the public interest.

Inquiries and comments should be addressed to: Office of Federal Patent Licensing, NTIS, Box 1423, Springfield, Virginia 22151.

EXHIBIT 1